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EXAMINER

SCUDERI, PHILIP S

ART UNIT PAPER NUMBER

2153

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,061

Applicant(s)

BETZLER, BOAS

Examiner

Philip S. Scuderi

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☒ Claim(s) 7, 17 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 7, 17, and 27 are objected to because of the following informality: “establishing connection of”. Examiner suggests the following: “establishing a connection ~~of~~ between”.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7-14, 16-25, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Ma et al. (US 5,995,500, hereinafter “Ma”).

4. With respect to claims 1, 10, 21, Ma discloses a program storage device readable by a machine, tangibly embodying at least one program of instructions executable by the machine (necessary in order to perform the following steps) to perform a method of establishing instant messaging communication between wireless devices, said method comprising:

employing an instant messaging (i.e., voice communication) server (12) to identify (610, column 9 lines 9-14) for a first wireless device (MS1) at least one additional wireless device (MS2) belonging to a same piconet (i.e., same communication cell) as the first wireless device (column 9 lines 9-14); and

responsive to said employing, establishing direct instant messaging communication (i.e., voice communication) (column 9 lines 17-20) between the first wireless device (MS1) and a second wireless device (MS2), wherein the second wireless device comprises one device of the at least one additional wireless device belonging to the same piconet (i.e., same communication cell) (column 9 lines 9-14), and wherein the direct instant messaging between the first wireless device (MS1) and the second wireless device (MS2) comprises direct wireless communication therebetween (column 9 lines 1-2, column 9 lines 17-20).

5. With respect to claims 2, 11, and 22, Ma discloses the device applied to claims 1, 10, and 21, wherein the establishing comprises transitioning the first wireless device (MS1) and the second wireless device (MS2) from client/server based communication with the instant messaging server (column 9 lines 9-14) to wireless peer-to-peer communication without need for the instant messaging server therebetween (column 9 lines 1-2, column 9 lines 17-20).

6. With respect to claims 3, 12, and 23, Ma discloses the device applied to claims 1, 10, and 21, wherein said employing comprises transmitting device address and access code information of the first wireless device to the instant messaging server to identify the piconet of the first wireless device (necessary in order to perform step 610), and transferring from the instant messaging server to the first wireless device available client device address and access code information to identify said at least one additional wireless device belonging to the same piconet as the first wireless device (necessary in order to contact MS2 directly, see column 9 lines 17-20 or figure 7).

7. With respect to claims 4, 13, and 24, Ma discloses the device applied to claims 3, 12, and 23, wherein said employing further comprises identifying at the first wireless device the second wireless device of said at least one additional wireless device belonging to the same piconet to which direct instant messaging communication is to be established (Figure 6 is merely an example communication. A subsequent direct communication between MS1 and another device reads on this limitation.).

8. With respect to claims 5, 14, and 25, Ma discloses the device applied to claims 3, 12, and 23, wherein the device address and access code information transmitted by the first wireless device identifies the piconet (column 9 lines 9-14) and a user of the first wireless device (identifying a device implicitly identifies the user of the device), and wherein the available client device address and access code information transferred to the first wireless device identifies a piconet (necessary in order to contact MS2 directly, see column 9 lines 17-20 or figure 7) and a user of each wireless device of the available clients (identifying a device implicitly identifies the user of the device).

9. With respect to claims 7, 17, 20, and 27, Ma discloses a program storage device readable by a machine, tangibly embodying at least one program of instructions executable by the machine (necessary in order to perform the following steps) to perform an instant messaging method, the method comprising:

establishing a connection (601-602, column 9 lines 1-6) between a first wireless client (MS1) to an instant messaging (i.e., voice communication) server (12);

sending a request from the first wireless client to the instant messaging server for identification of available wireless clients for instant messaging (requesting an in-range determination, column 9 lines 9-14);

receiving available wireless client information at the first wireless client from the instant messaging server (the in-range determination, column 9 lines 9-14); and

establishing direct wireless connection (column 9 lines 1-2) between the first wireless client (MS1) and a second wireless client (MS2) using the available wireless client information received from the instant messaging server (column 9 lines 17-20), wherein said direct wireless connection allows direct wireless communication between the first wireless client and the second wireless client (column 9 lines 1-2, column 9 lines 17-20).

10. With respect to claims 8, 18, and 28, Ma discloses the device applied to claims 7, 17, 20, and 27, wherein the available wireless client information comprises information allowing said first wireless client to identify (necessary in order to make the direction connection, see column 9 lines 17-20) at least one wireless client belonging to a same piconet as the first wireless client (column 9 lines 9-14), and wherein said direct wireless connection comprises a direct wireless piconet connection between the first wireless client and the second wireless client (column 9 lines 1-2, column 9 lines 17-20), wherein the second wireless client comprises one wireless client of said at least one wireless client belonging to the same piconet (column 9 lines 9-14).

11. With respect to claims 9, 19, and 29, Ma discloses the device applied to claims 7, 17, 20, and 27, wherein said establishing communication between said first wireless client and said instant messaging server comprises initializing connection to the instant messaging server through an access

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point (AP) (16) interface wired to the instant messaging server (see figure 1), wherein said first wireless client communicates by a wireless connection with the AP interface (see figure 1), and wherein the instant messaging server comprises a central depository connected to a wired network (see figure 1).

12. With respect to claim 16, Ma discloses an instant messaging system comprising:

a first wireless device (WS1, column 9 lines 9-14);

an instant messaging (i.e., voice communication) server (12) capable of responding to the first wireless device (e.g., see figure 7), said instant messaging server providing identifying information to the first wireless device on at least one additional wireless device belonging to a same piconet as the first wireless device (i.e., same communication cell) (column 9 lines 9-14); and

wherein the first wireless device is adapted to establish direct instant messaging communication with a second wireless device (column 9 lines 17-20), wherein the second wireless device comprises one device of the at least one additional wireless device belonging to the same piconet (i.e., same communication cell), and wherein the direct instant messaging communication between the first wireless device and the second wireless device comprises direct wireless communication therebetween (e.g., see column 9 lines 1-2).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 6, 15, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ma in view of Dehlin (US 2004/0203942).

15. With respect to claims 6, 15, and 26, Ma discloses the device applied to claims 1, 10, and 21. Ma does not disclose employing the Jabber instant messaging protocol and the Bluetooth standard for wireless communication in making a direct instant messaging connection between the first wireless device and the second wireless device.

16. The instant messaging applied to claim 1 is voice communication. Examiner takes Official Notice that it was well known in the art to use mobile devices to transmit text messages. It would have been obvious to one of ordinary skill in the art to send text messages using the devices taught by Ma, thereby enabling users to communicate in environments wherein voice communication would be difficult (e.g., in a loud room). Using the Jabber protocol would have been an obvious variation of the instant teachings, thereby providing an extensible messaging protocol.

17. Bluetooth is a wireless communication technology that forms similar communication cells (e.g., see specification paragraph 0024) it would have been obvious to one of ordinary skill in the art to apply the instant method to a Bluetooth network since throughput would similarly diminish when the communication is routed through a single node (Dehlin column 2 lines 11-29). Examiner takes Official Notice that Bluetooth networks usually route communication through a similar single (master) node.

Conclusion

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18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Grube et al. (US 5,666,661) discloses a method for switching to a direct mode of communication based on the geographic separation of communication devices.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSS



KRISNA LIM
PRIMARY EXAMINER